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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,079	01/20/2000	David R. Montague	2779.2.2	3921

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EXAMINER
MYHRE, JAMES W

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/488,079	Montague
Examiner	**Art Unit**
James W. Myhre	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jun 6, 2003* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-28* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. The amendment filed on June 6, 2003 has been considered but is ineffective to overcome the Dlugos Sr. et al (5,153,842) reference.

The amendment added new Claims 27 and 28. The active claims presently considered below are Claims 1-28.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5-12, 15-19, 22, and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dlugos Sr. et al (5,153,842).

Claims 1, 11, 18, and 24: Dlugos discloses a method and apparatus for attaching product labels comprising:

a. Affixing a label to a product surface (col 5, lines 48-56);

b. Configuring the label to provide information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and

c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the label (col 3, lines 39-42 and col 5, lines 48-59).

While it is not explicitly disclosed that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, it is noted that since Dlugos discloses that the instructions are executed on one or more computers (e.g. shipper's computer) that it is inherent that they would also be executable on the purchaser's computer or on any other computer. The actual type of instructions contained on the medium, whether a game program, assembly or operating instructions for the product, an infomercial for the product or for another product, or any other kind of program, does not alter the claimed apparatus of a computer readable medium containing computer readable instructions attached to the outside of a product using a label. Thus no patentable weight is given to how the computer instructions are being used after removal from the product or by whom.

Claims 2, 12, and 19: Dlugos discloses an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and further discloses the information is printed on the label (col 3, lines 19-23).

Claims 5, 15, and 22: Dlugos discloses an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and further discloses the computer readable medium containing information pertaining to product facts, source facts, data gathering interface, and many other types of information for use by the receiver, sender, and/or shipper (col 9, lines 49-62).

Claim 6: Dlugos discloses an apparatus for attaching product labels as in Claim 1 above, and further discloses that the label may be attached in various ways to a wide variety of products (col 5, line 48 - col 6, line 23).

Claim 7: Dlugos discloses an apparatus for attaching product labels as in Claim 6 above, and further discloses placing the label onto the product in a manner which protects the label from damage (col 5, lines 48-56).

Claims 8 and 16: Dlugos discloses an apparatus for attaching product labels as in Claims 1 and 11 above, and further discloses the label is a hang tag enclosing the computer readable medium (col 5, lines 48-56).

Claims 9 and 17: Dlugos discloses an apparatus for attaching labels as in Claims 1 and 11 above, and further discloses that the computer readable medium includes a printed medium or an electromagnetic medium (col 3, lines 19-23 and 39-52).

Claim 10: Dlugos discloses an apparatus for attaching product labels as in Claim 9 above, and further discloses that the computer readable medium is formatted as a bar code or embedded chip (col 3, lines 12-13, col 4, lines 52-57, and col 4, line 67 - col 5, line 8).

Claim 25: Dlugos discloses a method for attaching product labels as in Claim 24 above, and further discloses that the product is packaged with a "clear plastic film or packing material containing air bubbles" (col 5, lines 49-51).

Claim 26: Dlugos discloses a method for attaching product labels as in Claim 24 above, and further discloses that the label is attached to the outside of the product using a flexible member (i.e. the label is a tag)(col 5, line 60 - col 6, line 2).

Claims 27 and 28: Dlugos discloses an apparatus for attaching product labels, comprising:

a. A label affixed to a product surface at the source of the product (col 5, lines 48-56);

b. Configuring the label to provide advertising information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and

c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the product by the label (col 3, lines 39-42 and col 5, lines 48-59).

While it is not explicitly disclosed that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, it is noted that since Dlugos discloses that the instructions are executed on one or more computers (e.g. shipper's computer) that it is inherent that they would also be executable on the purchaser's computer or on any other computer. The actual type of instructions contained on the medium, whether a game program, assembly or operating instructions for the product, an infomercial for the product or for another product, or any other kind of program, does not alter the claimed apparatus of a computer readable medium containing computer readable instructions attached to the outside of a product using a label. Thus no patentable weight is given to how the computer instructions are being used after removal from the product or by whom.

It is also inherent that since the label in Dlugos is on the outside of the product, it is viewable by the prospective purchaser or anyone else who looks at the product.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 3, 4, 13, 14, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos Sr. et al (5,153,842).

Claims 3, 13, and 20: Dlugos discloses an apparatus for attaching product labels as in Claims 2, 12, and 19 above, but does not explicitly disclose that the printed information is contained in a selection of color on the label. Official Notice is taken that it is old and well known within the marketing arts to use color to differentiate between various labels and tags; such as a clothing store using pink hang tags to indicate that the garment's size is Small, light blue hang tags to indicate that the garment's size is Medium, and green hang tags to indicate that the garment's size is Large. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use labels of various colors in Dlugos. One would have been motivated to use labels of different color in order to facilitate quick and easy identification of

the product or product manufacturer by the merchant, the shipper, and the customer (e.g. a blue label for a product made by IBM, whose nickname is "Big Blue").

Claims 4, 14, and 21: Dlugos discloses an apparatus for attaching product labels as in Claims 1, 11, and 18 above. While Dlugos prefers that the label is the same size and shape as a credit card, it is also disclosed that the label "may be of an overall shape or size different from the standard credit card" (col 6, lines 11-23). However, Dlugos does not explicitly disclose using a trademark symbol on the label to identify the product or the source of the product. Official Notice is taken that it is old and well known within the marketing arts to use trademark symbols to identify both products and product sources; indeed, that is the purpose for registering trademarks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a trademark symbol on the label in Dlugos. One would have been motivated to include a trademark symbol on the label in order to facilitate quick and easy identification of the product and its source.

Claim 23: Dlugos discloses an apparatus for attaching product labels as in Claim 18 above. While various methods of attaching the label to the product are disclosed, including inserting the label into a small pouch, using clips or brackets, etc., it is not explicitly disclosed that the opening into which the label is inserted penetrates all the way into the interior of the product. However, it would have been obvious that such a method of attachment could be used, depending upon the actual product, of course. One would have been motivated to use this or other methods to attach

the label to the product in order to prevent or reduce the likelihood that the label would become detached during shipping or handling as discussed by Dlugos.

Response to Arguments

6. Applicant's arguments filed June 6, 2003 have been fully considered but they are not persuasive.

The Applicant argues that the invention "do not currently read on, nor have ever read on inventory tags, shipping manifests, shop travelers, bar code price tags" (page 10) and that the product label is "clearly a point-of-sale label"..."not to be confused with any convenient tagging system used by a manufacturer or handler typically for its own purpose exclusively" (page 11). The Examiner notes that both Dlugos and the present claims clearly indicate that the label is affixed at the source of the product, not at the point-of-sale. Furthermore, the Applicant is attempting to overcome the prior art by citing a particular intended use for the label or, more accurately, excluding the particular intended uses for the label as were disclosed in the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant also argues the term "coupled" is used in the claims to indicate that the computer readable medium is physically attached to the product or product packaging by the label. The Examiner notes that Dlugos also explicitly discloses that the computer readable medium is attached to the product using an adhesive layer, a slot, an envelope, or other attachment means such as Velcro portions, a clip, or a bracket (col 5, line 48 - col 6, line 2) in addition to containing information "linking" it to the product.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Noda et al (US2001/0054014) discloses an apparatus for providing a customer with a CD-RW with a product and using that CD-RW to record the transaction data, customer registration data, advertisements about the product, etc.

B. May (4,511,033) discloses an apparatus for attaching a promotional laminated record to a product for use by a customer device.

C. Froehlig (3,340,999) discloses an apparatus for attaching a small (45 rpm) record to the packaging of a larger (33 rpm) record using various means to make the attached record noticeable by the customer, such as using a printed or clear envelope (i.e. label) attached to the outside of the product packaging.

D. Strauss (3,000,640) discloses an apparatus for attaching an audible record to a product for use by the purchaser of the product.

E. Brown (2,714,448) discloses an apparatus in which an audio record is incorporated into the packaging of a food container such as a cereal box.

F. Labowitz et al (2,020,381) discloses an apparatus for attaching a sound record containing advertising material to a product into a recessed portion of the lid using an adhesive label in a manner similar to the claimed invention.

G. Andrews (WO 01/11530) discloses an apparatus for placing a tag on a product for use by the purchase of the product to access information such as the user manual, warranty, repairs, supplies, or replacement parts information.

H. Rueben (CA 2,176,321) discloses an apparatus for placing an audible tag on a product for use by the purchase of the product, the tag containing an electronic program circuit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
July 29, 2003

James W. Myhre
Primary Examiner
Art Unit 3622